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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,613	12/16/2003	Shigeo Fukuda	FUKU3001/EM	2775

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EXAMINER

RESAN, STEVAN A

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,613

Applicant(s)

FUKUDA, SHIGEO

Examiner

Stevan A. Resan

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-16-2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 contain alpha-numeric characters that are not claim limitations and that refer to drawings that are not part of the claims.

In addition claim 6 contains the phrases "such as " and "and the like". These phrases are deemed indefinite.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yellen US 6427486. See Fig 1 and Summary of the invention.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2, 3, 5 as applied to claim 1 and Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yellen US 64274 in view of Ishikawa US 4,095,587 and Hoffman US 4517217.

Yellin disclose the invention as disclosed in claims 1 and 4. Yellin suggests that the magnets may be coated (Col 1 lines 49-50. Hoffman teaches protective coatings applied to plated layers of jewelry (See abstract). Therefore it would have been obvious to one of ordinary skill in the art to plate or coat the magnets for aesthetic and or protective reasons. The forming of plated layers (e.g. gold) and other protective layers (e.g. colored glass) are old in the jewelry art and have been utilized for these aesthetic reasons.

Substitution of equivalent coatings requires no express motivation as long as the prior art recognizes the equivalency.

In re Fount 213 USPQ 532 (CCPA 1982); In re Siebentritt 152 USPQ 618 (CCPA 1967); Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co. 85 USPQ 328 (USSC 1950).

Yellin does not disclose the use of permanent magnets that are rare earth magnets. However Ishikawa teach the use of rare earth magnets in jewelry to promote health (Col 3 line 19). Therefore it would have been obvious to one of ordinary skill in the art to use rare earth magnets in the jewelry of Yellin for this purpose. Note that the magnets of Ishikawa are magnetized in the radial direction. (Col 3 line 5).

The examiner also points out that rare earth magnets are noted for their larger coercive force and therefor it would have been obvious to one of ordinary skill in the art

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to use these magnets in the jewelry of Yellin since the magnets of Yellin depend on strong magnetic force (i.e. coercive force) to hold the components of the circular band of magnets together.

The changing of the shape as in claims 1-4, 6-9, absent persuasive evidence that a particular configuration is significant, would have been obvious to one of ordinary skill in the art as a matter of design choice for aesthetic reasons. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ogikubo US 5347253 is cited for teaching spherical magnets.

Hart US 5195335 is cited for teaching the use of spherical or cylindrical magnetic beads in a necklace.

Tanaka US 3885383 is cited for teaching an expandable band comprising cylindrical magnets.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (571) 272-1513. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1285

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.


STEVAN A. RESAN
PRIMARY EXAMINER